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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91203277
Party	Plaintiff 3D International, LLC
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Date	08/13/2013
Attachments	Reply.pdf(110651 bytes )

1                   **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
2                   **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

3 In the Matter of Trademark Application Serial Nos. 85261047 & 85312684

4 Mark: AUTOPIA FORUM; AUTOPIAFORUMS

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7 3D INTERNATIONAL, LLC, a  
California limited liability company.

8                                   Opposer,

9                                   v.

10 PALM BEACH MOTORING  
11 ACCESSORIES, INC.,  
a Florida corporation

12                                   Applicant.  
13

Opposition Nos. 91203277 (parent)  
91203279

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16                   **OPPOSER’S REPLY IN SUPPORT OF OPPOSER’S**  
17                   **MOTION TO COMPEL DISCOVERY RESPONSES,**  
18                   **TO RESET DISCOVERY AND TRIAL, AND FOR SANCTIONS**  
19

20                   Opposer 3D International, LLC (“3D”), by its attorney Thomas Cook, submits this Reply  
21 brief in support of **OPPOSER’S MOTION TO COMPEL RESPONSES TO: (to enumerated**  
22 **discovery requests), AND OPPOSER’S REQUEST TO RESET DISCOVERY AND**  
23 **TRIAL, AND FOR SANCTIONS** (Opposer 3D’s “Motion”), and in reply to “Applicant’s Brief  
24 in Opposition to Opposer’s Motion to Compel Discovery Response, to Reset Discovery and  
25 Trial, and for Sanctions,” filed by Applicant PALM BEACH MOTORING ACCESSORIES,  
26 INC. (“PBMA”). To the extent the following facts are asserted by counsel for 3D in this matter,  
27 counsel has personal knowledge of all matters set forth herein.

28 ///

1 3D has now received responses to each of its discovery requests noted in its Motion.  
2 Accordingly, 3D's request that the Board compel PBMA's responses to discovery requests  
3 (request "a" of the Motion) is now moot. What remains in this Motion is:

- 4 b. Opposer's request to reset the discovery and trial calendar in these
- 5 consolidated cancellation actions, and,
- 6 c. Opposer's request that all Opposer's Requests for Admissions served thus
- 7 far be deemed admitted by Applicant, and all objections to Opposer's
- 8 discovery served thus far be waived by Applicant.

## 10 ARGUMENT

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12 1. As 3D notes in its Motion, it served Opposer's first set of discovery  
13 requests on PBMA August 10, 2012 (see proof of service date for such discovery attached as  
14 Exhibit A to 3D's Motion). With the 30-day response period for responses to that discovery, and  
15 the additional five days allowed for service by mail, PBMA's responses were due September 14,  
16 2013. As PBMA notes, 3D agreed to a 30-day extension for PBMA to respond to 3D's discovery  
17 requests. With such 30-day extension, PBMA's responses were due for service on or before  
18 October 14, 2012. PBMA has now acknowledged that it did not serve responses to discovery on  
19 or before October 14, 2012, but instead filed and served its Motion for Summary Judgment on  
20 October 15, 2012, convinced that the Motion for Summary Judgment "served to suspend the  
21 proceedings including PBMA's obligation to respond to 3D's outstanding discovery requests."  
22 (Zucker Declaration, pars. 4 & 5).

23 2. Counsel for PBMA cites the case of *Benedict v. Super Bakery Inc.* in support of  
24 PBMA's position that discovery obligations were also suspended, saying this case "clarified" that  
25 obligation. However, *Benedict*, a case decided on other grounds, acknowledges the Board has  
26 now restated the Rule 2.127(d). 3D asserts that *Benedict* does not provide any clarification of  
27 PBMA's discovery obligations while a potentially dispositive motion is pending.

1           3.       PBMA also asserts in the first paragraph of its Response argument that  
2 3D “had received the bulk of its requested discovery” at the time 3D filed its Motion. However,  
3 when 3D filed its Motion on May 27, 2013, 3D had only received PBMA’s Responses to  
4 Opposer’s Requests for Admissions, Set One (served by PBMA on May 16, 2012) and PBMA’s  
5 Responses to Opposer’s Requests for Admissions, Set Two (served by PBMA on May 17, 2012).  
6 3D had not received, and could not have received, PBMA’s Responses to Opposer’s Requests for  
7 Production, Sets One and Two (served by PBMA on May 17, 2012), or PBMA’s Responses to  
8 Opposer’s Interrogatories, Sets One and Two (also served by PBMA on May 17, 2012). Two out  
9 of six responses is not “the bulk” of PBMA’s responses.

10           4.       PBMA’s also asserts that 3D “knew by an agreement between counsel that  
11 when 3D received the response, PBMA was then preparing responses to 3D’s First and Second  
12 Sets of Interrogatories and Document Requests, and that services of those responses on 3D was  
13 imminent.” (PBMA Response, top of page two). However, 3D’s acknowledgment that PBMA’s  
14 May 13 email was received “with thanks” (Zucker Declaration, par. 11) cannot reasonably be  
15 interpreted as an “agreement” by 3D to anything substantive.

16           5.       PBMA also assert’s 3D’s statement that PBMA “has said nothing  
17 about when such responses will be returned” is untrue. However, Exhibit H to PBMA’s  
18 response, to which PBMA points for support, says “We are in the process,” and “I will send  
19 PBMA’s response to you as each set is completed,” and “by the middle of next week, at which  
20 time we will also reply to the remaining items raised in your e-mail of May 6, below.” However,  
21 these somewhat nebulous statements about discovery responses come nine months after 3D’s  
22 discovery was served, at a time when no responses had been received. The nebulous statements  
23 also come after PBMA began to bargain for a suspension of this case, after which, PBMA  
24 assured, “the discovery period would be reset and PBMA would then respond to 3D’s  
25 outstanding requests.” (Zucker Declaration, par. 9, emphasis supplied). These statements also  
26 came almost one month after the Board denied Applicant’s Motion for Summary Judgment, the  
27 motion upon which PBMA has based its delay (and even refusal) in supplying discovery  
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1 responses, during the pendency of which PBMA had supplied no responses to discovery.<sup>1</sup>

2           6. Continuing with PBMA's Response, PBMA apparently wishes the Board to  
3 take something from 3D's "failing to advise the Board of 3D's receipt of all the sought  
4 responses." However, since "all the sought responses" were not received by 3D until after its  
5 Motion was filed, this Reply is the first time 3D could advise the Board of the receipt of the  
6 remaining discovery responses, and it has now done so.

7           7. PBMA apparently also wishes the Board to take something from 3D's  
8 December 17, 2012 "Answer" to PBMA's Motion for Summary Judgment, without first seeking  
9 to compel discovery responses (Zucker Declaration, par. 6). However (assuming PBMA's point  
10 is some kind of waiver), while 3D's gives up the right to receive such responses before it  
11 "Answers" Applicant's Motion for Summary Judgment, 3D does not give up the right to such  
12 responses until Applicant's Motion for Summary Judgment is decided.

13           8. The fact remains that PBMA has delayed its responses to discovery and has,  
14 with its refusal to supply discovery responses while its Motion for Summary Judgment was  
15 pending, effectively shortened the time during which 3D could conduct discovery in support of  
16 its case. Meanwhile, the discovery and trial schedule set by the Board with its decision on the  
17 Motion for Summary Judgment is still running. PBMA's failure to respond to discovery, and its  
18 position that it will not provide discovery pending the decision on its Motion for Summary  
19 Judgment, is inconsistent with the rules, and PBMA has acted against 3D's right to conduct  
20 discovery in that effort to demonstrate prior trademark rights in these consolidated cases.

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22           WHEREFORE, based on the foregoing, 3D respectfully requests:

23           1. The Board issue an Order pursuant to 37 CFR 2.120(e), ordering Applicant to  
24 immediately provide full and complete responses to all Applicant's future discovery requests.

25           2. The Board issue an Order holding Opposer's Requests for Admissions are, by  
26 Applicant's failure to respond, deemed admitted. These requests include: (i) **OPPOSER'S**

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<sup>1</sup> As an aside, we might also note that 3D also has still not received any "reply to the remaining items"  
(settlement proposal) to which PBMA refers its brief.

1 **REQUESTS FOR ADMISSIONS, SET ONE, and (ii) OPPOSER'S REQUESTS FOR**  
2 **ADMISSIONS, SET TWO.**

3 3. The Board issue an Order holding Applicant may not object to Opposer's remaining  
4 outstanding discovery. This discovery includes: (iii) **OPPOSER'S INTERROGATORIES,**  
5 **SET ONE, (iv) OPPOSER'S REQUESTS FOR PRODUCTION OF DOCUMENTS AND**  
6 **THINGS, SET ONE, (v) OPPOSER'S INTERROGATORIES, SET TWO, (vi)**  
7 **OPPOSER'S REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS, SET**  
8 **TWO.**

9 4. The Board issue and Order resetting the discovery and trial schedule in these  
10 consolidated actions to provide Opposer 3D sufficient time to conduct its case, and further  
11 discovery 3D wishes to serve in its effort to demonstrate its case. In view of the delay Applicant  
12 has occasioned through its failure and refusal to respond, 3D believes an appropriate  
13 rescheduling of discovery and trial will include an additional ten (10) months over the schedule  
14 the Board set on April 16, 2013. Accordingly, 3D requests the Board reschedule discovery and  
15 trial in these consolidate proceeding as follows:

16 Expert Disclosures Due 4/1/2014  
17 Discovery Closes 5/1/2014  
18 Plaintiff's Pretrial Disclosures 6/15/2014  
19 Plaintiff's 30-day Trial Period Ends 7/29/2014  
20 Defendant's Pretrial Disclosures 8/14/2014  
21 Defendant's 30-day Trial Period Ends 9/28/2014  
22 Plaintiff's Rebuttal Disclosures 10/13/2014  
23 Plaintiff's 15-day Rebuttal Period Ends 11/12/2014

24 5. For all other relief that this Board may deem proper.

25 Respectfully submitted,

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27 Date: August 13, 2013

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Date: August 13, 2013

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Thomas W. Cook

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Thomas Cook

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